

Amendment
Application No. 09/871,605
Attorney Docket No. 010713

REMARKS

Claims 1, 3-7 and 9-12 are pending. Claims 1 and 7 are herein amended.

Claim Rejections - 35 U.S.C. § 112

Claims 1, 3-7 and 9-12 were rejected under 35 U.S.C. § 112, second paragraph, as being incomplete. In claims 1 and 7, the limitation, “operator,” has been amended to “human operator” to clearly recite that the “operator” is a person.

Withdrawal of the rejection is requested.

Claim Rejections - 35 U.S.C. § 103

Claims 1, 3-7 and 9-12 were rejected under 35 U.S.C. § 103(a) as being unpatentable over **Eisenhart** (U.S. Patent Application Pub. No. 2001/0047276) in view of **Dworkin** (U.S. Patent 6,026,148). Favorable reconsideration is requested.

A. Eisenhart in view of Dworkin does not Disclose a Human Operator

Applicant respectfully submits that Eisenhart in view of Dworkin does not disclose:

using a *human operator* to select *members* for which provision of information is to be requested, by utilization of information about the *members* registered in the membership database; then

using the same *human operator* to request the selected *members* to offer engineering information by way of the communications network

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as recited in amended claim 1, and

means for a *human operator* to select *members* for which provision of information is to be requested, by utilization of information about the *members* registered in the membership database;

means for the same *human operator* to then request the selected *members* to offer engineering information by way of the communications network

as recited in amended claim 7.

The Examiner alleged that Eisenhart teaches the steps of compiling a list of members by utilization of information about members registered in the membership database and teaches the step of transmitting engineering information by means of a communications network. (Office Action, pages 6-7.) The Examiner acknowledged that Eisenhart does not disclose a step of using an operator to select members and to request engineering information from the selected members. (Office Action, page 7.) However, the Examiner cited Dworkin for disclosing this feature. (Office Action, page 7, citing Dworkin, col. 2, lines 7-9; col. 7, lines 11-22.)

Dworkin discloses that a user, and not an operator, can manually select an expert to direct a question to. Dworkin discloses a computer-based system which facilitates the exchange of information between users and expert respondents. (Abstract.) Dworkin discloses that a user logs on to the system and creates a question to store in the memory of the central computer. (Col. 2, lines 5-7.) An expert respondent is then selected, either *manually by the user* or automatically by the system. (Col. 2, lines 7-10.) Dworkin discloses that the system, or electronic operator as alleged by the Examiner, can be bypassed in order for the user to directly

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ask an expert a question. Thus, Dworkin discloses that either an electronic operator is used or that no operator at all is used. Therefore, Eisenhart in view of Dworkin does not disclose the elements as recited in claims 1 and 7.

B. No Motivation to Combine Eisenhart and Dworkin

Even if Dworkin discloses the claimed elements that are not disclosed in Eisenhart as alleged by the Examiner, Applicant respectfully submits that one of ordinary skill in the art at the time of the present invention would not have been motivated to combine the teachings of Eisenhart and Dworkin.

The Examiner stated that it would have been obvious to modify the teachings of Eisenhart to include the teachings of Dworkin

because the resulting combination would facilitate the pairing of said user with an expert able to answer said user's question based on said expert's membership information and areas of expertise more efficiently.

(Office Action, page 8.) However, the Office Action does not explain how the Eisenhart system would be more efficient, if it were modified to replace a previously automated process with a process requiring human involvement. Given the great prevalence of automating processes (that is, reducing human involvement) to increase efficiency, the Examiner describes a modification that is *less* efficient.

Moreover, the statement quoted above from the Office Action is a description of an alleged advantage that would have been the result of the modification. The Office Action needs

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to explain why, before the modification, one skilled in the art would have thought about such modification and suspected the alleged advantage. A proper modification is not shown by stating how, after learning of the modification, one skilled in the art would have thought that it was advantageous. Although the Office Action alleged that Dworkin suggests a more efficient system, the Office Action does not cite any explanation in the prior art, which explains how Dworkin supposedly suggests that a modification therefrom would have been more efficient.

Therefore, one of ordinary skill in the art at the time of the present invention would not have been motivated to modify Eisenhart with teachings of Dworkin.

Claims 3-6 depend from claim 1 and claims 9-12 depend from claim 7. Thus, for at least the foregoing reasons, claims 1, 3-7 and 9-12 distinguish over the cited art and define patentable subject matter. Accordingly, withdrawal of the rejection of claims 1, 3-7 and 9-12 is hereby solicited.

In view of the aforementioned amendments and accompanying remarks, Applicant submits that the claims, as herein amended, are in condition for allowance. Applicant requests such action at an early date.

If the Examiner believes that this application is not now in condition for allowance, the Examiner is requested to contact Applicant's undersigned attorney to arrange for an interview to expedite the disposition of this case.

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If this paper is not timely filed, Applicant respectfully petitions for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,

WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP

A handwritten signature in black ink, appearing to read 'A.G. Melick', with a stylized flourish at the end.

Andrew G. Melick

Attorney for Applicant

Registration No. 56,868

Telephone: (202) 822-1100

Facsimile: (202) 822-1111

AGM/tw